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Loren Eckart

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EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/830,115

Applicant(s)

ECKART ET AL.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63, 74-84 and 90-102 is/are pending in the application.
- 4a) Of the above claim(s) 74-84 and 90-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 and 100-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2006 has been entered.

Claims 1-63, 74-84 and 90-102 are currently pending. Claims 1-63 and 100-102 have been elected without traverse. Accordingly, claims 74-84 and 90-99 are withdrawn from further consideration.

Of the elected claims, claims 1, 3, 7, 9-10, 16, 24, 28, 33-35, 39, 42, 47, 55, 57, 59, 100-102 have been amended. Claims 1-63 and 100-102 are examined below.

Response to Amendment

2. Applicant's amendments to elected claims 1, 3, 7, 9-10, 16, 24, 28, 33-35, 39, 42, 47, 55, 57, 59, 100-102 are acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-63 and 100-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not readily apparent that the amended claims with the new limitations of obtaining a *trial balance report* and converting data in the trial balance report to a standardized format, have support in the specification. The examiner reviewed the specification and can only find support for ledgers, income statements, balance sheets and cash flow statements on pages 11-12. Examiner respectfully requests Applicant to point out in the specification where it specifically discloses that financial performance data from a *trial balance report* is obtained and converted to a standardized format in case she inadvertently missed the disclosure in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-63 and 100-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All of the independent claims recite

creating a standardized database that comports with "generally accepted accounting principles." It is not clear what generally accepted accounting principles the claims are referring to, particularly since there exist Generally Accepted Accounting Principles (GAAP) established by the Federal Accounting Standards Advisory Board (FASAB) and the claims, as currently recited, do not explicitly indicate they mean the GAAP established by the FASAB. Applicant is respectfully requested to clarify what generally accepted accounting principles the claims are referring to, particularly if they differ from the GAAP established by the FASAB. For examination purposes, Examiner is interpreting generally accepted accounting principles to mean the GAAP established by the FASAB.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-63 and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, II et al. (U.S. 6,850,643).

As per claim 1, Smith, II et al. discloses a method for automated management and standardization of performance information associated with at least one business, the method comprising:

obtaining performance information associated with a business, the performance information originating from a financial accounting software system used by the business, and storing the information as electronic data on a data processing system, the performance information having a first format based on a first set of performance classifications (col. 3, lines 23-32 and 46-54; col. 4, lines 6-8; col. 5, lines 17-24; Figure 1; Legacy accounting systems of borrowing customers send financial data to the main lending system via the Internet. The financial data received from the borrowing customers may be in arbitrary formats based on the financial reports used by the legacy systems of the borrowing customers.);

converting, using an automated process executing on the data processing system, the performance information from the first format to a second standardized format based at least in part on a mapping of one or more performance classifications of the first set of performance classifications to one or more respective performance classifications of a second set of standardized performance classifications (col. 4, lines 8-23; col. 7, lines 1-17; The arbitrary formats the financial data is received from borrowing customers are converted to predefined formats for analysis and reporting by the lending system.);

aggregating the converted performance information with performance information associated with at least one other business, thereby creating a standardized database of private company performance information across a receiving institution's portfolio (col. 3, lines 46-54; col. 17, lines 29-37; col. 18, lines 1-11, 28-35 and 54-65; Figures 25-27 show the determining of accounts payable, accounts receivable and inventory

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performance. Customer financial performance is aggregated, compared with loan covenants and analyzed against historical trends in similar industries. Customers are business owners seeking loans.);

analyzing the converted performance information associated with the business based at least in part on one or more performance metrics (col. 2, lines 39-46; col. 4, lines 24-33; The converted financial data is analyzed using various reporting and analysis tools that assess risk-related metrics. Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance. The performance information is for customers, who are business owners seeking a loan.); and

generating at least one electronic report based on the results of the analyzing for the business whose performance information was obtained (col. 2, lines 39-46; col. 4, lines 24-33; col. 19, lines 16-33; The system generates various reports reflecting different financial performance analyses. The reports are generated for printing as well as interactive online use. Financial reports are generated for customers, who are business owners seeking a loan.).

Smith, II et al. does not expressly disclose that the performance information comes from a trial balance report. However, Smith, II et al. does disclose using well-known financial performance instruments such as general ledgers (col. 3, lines 26-30). Additionally, it is old and well known in the art of financial analysis/accounting to use trial balance reports as a means to convey financial performance data of a business. Furthermore, Examiner submits that, as the claims are currently recited, the type of document the performance data is obtained from is non-functional descriptive data. The

recited method steps would be performed the same regardless of the specific document the performance data is obtained from. Further, for the system claims, the structural elements remain the same regardless of the specific document the performance data is obtained from. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106. Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Smith, II et al. to obtain performance information from trial balance reports in addition to general ledgers in order to work with the specific performance information that is available in trial balance reports, thereby enhancing the flexibility of the system of Smith by enabling the management and standardization of performance information of trial balance reports in addition to the existing ability of Smith to manage and standardize performance information of general ledgers.

Additionally, Smith, II et al. does not expressly disclose the standardized information comporting with generally accepted accounting principles. However, it is old and well known in the art of financial analysis/accounting to standardize financial data with GAAP in order to conform to accounting policies and procedures established by the government, or the Federal Accounting Standards Advisory Board (FASAB). Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Smith, II et al. so the standardized information comports with generally accepted accounting principles in order to adhere to accounting

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policies and procedures well-established by the government, thereby adhering to standards commonly used in the industry and thus, making the information easily portable.

As per claim 2, Smith, II et al. discloses the method as in Claim 1, further comprising: generating one or more performance reports based on the analysis of the converted performance information (col. 19, lines 16-33).

As per claims 3 and 16, Smith, II et al. discloses the method as in Claims 2 and 1, wherein the system uses alerts to notify users of information that requires their attention or to indicate a required action (col. 4, line 66-col. 5, line 2). Smith, II et al. also discloses comparing the customer's performance data with historical and industry standards to determine a deviation (col. 18, lines 1-11). Additionally, it is old and well known in the art of financial analysis/accounting to set thresholds to better quantify and analyze data against some criteria. Smith, II et al. does not expressly disclose at least one alert indicator to identify whether a metric exceeds an adjustable threshold set by the requesting party. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the financial performance analyses of Smith, II et al. to use alerts to notify users of a variance exceeding a predetermined value or threshold (where Smith already teaches alerts and comparisons of data to historical and industry standards) as doing so would enhance the financial analyses and reporting system of Smith, II et al. by particularly pointing out how the customer compares with a specific industry standard or threshold, which further helps the lending

system to determine whether or not the customer's business is viable for a credit increase or specific loan, which is the goal of the system.

As per claims 4 and 17, Smith, II et al. discloses the method as in Claims 3 and 16, wherein the predetermined value includes a value of the performance metric from a previous period (col. 18, lines 1-11; The system compares the customer's performance data with historical information and industry standards.).

As per claims 5 and 18, Smith, II et al. discloses the method as in Claims 3 and 16, wherein the predetermined value includes a target value set for the at least one performance metric (col. 17, lines 49-62; col. 18, lines 1-11; The system compares the customer's performance data with historical information and industry standards to detect deviations from some identified target value or criteria.).

As per claims 6 and 19, Smith, II et al. discloses the method as in Claims 3 and 16, wherein the predetermined value includes a value representative of performance values for other businesses (col. 18, lines 1-11; The system compares the customer's performance data with historical information and industry standards.).

As per claim 7, Smith, II et al. discloses the method as in Claim 1, further comprising the steps of:

obtaining performance information associated with a second business, the performance information having a third format based on a third set of performance classifications (col. 3, lines 23-32 and 46-54; col. 4, lines 6-8; Figures 1 and 2; Legacy accounting systems of borrowing customers send financial data to the main lending system via the Internet. The financial data received from the borrowing customers may

be in arbitrary formats based on the financial reports used by the legacy systems of the borrowing customers. Figures 1 and 2 show an exemplary network of at least two borrowing customers submitting data from their legacy systems in different formats as well as a third-party customer submitting their data in their own format.);

converting, using an automated process, the performance information associated with the second business from the third format to the second format based at least in part on a mapping of one or more performance classifications of the third set of performance classifications to one or more respective performance classifications of the second set of performance classifications (col. 12, lines 12-52; col. 14, lines 19-27; Figure 19; Data formats from borrowing customers and third-party customers are converted to different classifications of formats based on whether the data is being inputting into a database or based on the type of financial report being generated. Different financial reports require different pertinent data in specific formats; thus, each financial report has its own classification of data.);

aggregating the converted performance information associated with the second business with the other aggregated performance information (col. 17, lines 29-37; col. 18, lines 1-11, 28-35 and 54-65; Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance. Customer financial performance is aggregated, compared with loan covenants and analyzed against historical trends in similar industries.); and

analyzing the converted performance information associated with the second business based at least in part on one or more performance metrics (col. 4, lines 24-33;

The converted financial data is analyzed using various reporting and analysis tools that assess risk-related metrics. Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance.).

As per claim 8, Smith, II et al. discloses the method as in Claim 7, further comprising:

generating one or more performance reports based on results of the analysis of the converted performance information associated with the second business (col. 4, lines 24-33; col. 19, lines 16-33; The system generates various reports reflecting different financial performance analyses. The reports are generated for printing as well as interactive online use.).

As per claim 9, Smith, II et al. discloses the method as in Claim 7, further comprising:

analyzing at least one performance metric of at least one of the first and second businesses based on one or more representative performance metrics from the aggregated converted performance information (col. 17, lines 29-37; col. 18, lines 1-11, 28-35 and 54-65; Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance. Customer financial performance is aggregated, compared with loan covenants and analyzed against historical trends in similar industries.).

As per claim 10, Smith, II et al. discloses the method ms in Claim 1, wherein obtaining the performance information includes receiving the performance information as one or more data files uploaded via a website (col. 4, lines 6-8, 41-48 and 62-64; col.

7, lines 31-39 and 54-56; Figures 1 and 2; Customers may upload their financial data to the lending system via a website.).

As per claim 11, Smith, II et al. discloses the method as in Claim 1, further comprising providing the one or more performance reports to at least one requesting party (col. 3, lines 13-16; The lending system may communicate with third-party customers such as auditors.).

As per claim 12, Smith, II et al. discloses the method as in Claim 11, wherein the one or more performance reports are provided via a website (col. 1, lines 44-45; col. 4, lines 41-48; col. 7, lines 21-39; Financial data is sent and received via a web browser.).

As per claim 13, Smith, II et al. discloses the method as in Claim 1, wherein the conversion of the performance information from the first format to the second format is performed at least in part using one or more software programs (col. 4, lines 19-23; col. 12, lines 3-62; The system uses scripts to perform the conversion of financial performance data from one format to another.).

As per claim 14, Smith, II et al. discloses the method as in Claim 13, wherein the performance information is converted from the first format to the second format using a conversion map indicating correlations between performance classifications of the first set of performance classifications and performance classifications of the second set of performance classifications (col. 12, lines 12-52; col. 14, lines 19-27; Figures 19 and 24-27; Data formats are converted to different classifications of formats based on whether the data is being inputting into a database or based on the type of financial report being

generated. Different financial reports require different pertinent data in specific formats; thus, each financial report has its own classification of data.).

As per claim 15, Smith, II et al. discloses the method as in Claim 1, wherein the business is one of a group consisting of: a private business; a public business; a non-profit organization; and a government agency (col. 3, lines 13-15; col. 16, lines 63-64; items 36 and 38 in Figures 1 and 2).

As per claim 20, Smith, II et al. discloses the method as in Claim 16, wherein the alert is delivered via at least one of the group comprising: an email; a facsimile; a voice message; and a text message (col. 4, line 66-col. 5, line 2).

As per claim 21, Smith, II et al. discloses the method as in Claim 1, further comprising:

delivering at least a portion of the converted performance information to a requesting party as one or more data files having a format compatible with software operated by the requesting party (col. 4, lines 8-11; col. 7, lines 1-10; col. 12, lines 12-23; The performance data is converted into predefined formats for use in automated analysis and reporting. The predefined formats are determined by how the performance data is to be used (i.e., submitted in a database or used for a specific financial report).).

As per claim 22, Smith, II et al. discloses the method as in Claim 1, wherein the performance information includes financial information (col. 3, lines 28-32 and 47-54; Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance, which are related to the operational performance of a business. The conversion of data formats includes both business and financial data such as

financial reports, account balance, general ledger, accounts receivable and accounts payable.).

As per claim 23, Smith, II et al. discloses the method as in Claim 1, wherein the performance information includes operational information and where one or more of the performance classifications of the first set of performance classifications includes an operational classification and one or more of the performance classifications of the second set includes an operational classification correlated to a operational classification of the first set (col. 3, lines 28-32 and 47-54; col. 16, lines 63-64; The system uses a client's operational performance of its business to assess lending information. Figures 25-27 show the determining of accounts payable, accounts receivable and inventory performance, which are related to the operational performance of a business. The conversion of data formats includes both business and financial data such as financial reports, account balance, general ledger, accounts receivable and accounts payable.).

Claims 24-63 and 100-102 recite substantially similar subject matter as claims 1-23 above. Therefore, claims 24-63 and 100-102 are rejected on the same basis as claims 1-23 above.

Additionally, with regard to claims 33 and 100, Smith, II et al. discloses web-based financial reporting detailing financial performance of a customer, including comparisons with historical trends, thereby enabling financial analysis via a web-based

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report/interface (col. 2, lines 45-46; col. 3, lines 1-20; col. 4, lines 41-48; col. 15, lines 28-30; col. 16, lines 57-59; col. 17, lines 29-34; col. 18, lines 1-7).

Response to Arguments

9. Applicant's arguments are moot in view of the new and updated grounds of rejections provided above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Speakman et al. (U.S. 5,991,741) discusses a financial analysis model.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. Michelle Tarae
Patent Examiner
Art Unit 3623

November 27, 2006